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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/30/2008

EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

10/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/006,267	Applicant(s) FALYS ET AL.	
	Examiner DANIEL L. GREENE	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-26, 30-32, 47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-26, 30-32, 47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/3/2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-15 and 17-46 were pending in the application. In the response received 7/3/2008 applicant cancelled claims 27-29 and 33-46 and added new claims 47 and 48. Claims 1-15 and 17 were withdrawn as being directed toward a nonelected invention on 6/13/2007. An action on the merits of claims 18-26, 30-32, 47 and 48 follows.

Drawings

2. The drawing received 7/3/2008 is acceptable and obviates the objection set forth in section 4 of the previous Office action mailed 4/3/2008.

Specification

3. Applicants' amendments to the specification are acceptable which obviates the objections set forth in section 5 of said previous Office action.

Response to Arguments

4. Applicant's arguments with respect to claims 18-26 and 30-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 18-26, 30-32, 47 and 48 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims do not require the use of technological arts to be performed. That is, the claims can be performed by hand by people with pencils, paper and a filing cabinet.

Claims 1 and 2 recite a series of steps and are considered for the purpose of analysis under 35 U.S.C. 101 as merely reciting a series of steps. The claims do not recite a “pre” or “post” computer activity but merely perform a series of steps of selecting, adjusting and transmitting a trading order that does not explicitly require a computer.

A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8).

Further, the claims merely manipulate an abstract idea (selecting and adjusting) or perform a purely mathematical algorithm without limitation to any practical application.

A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335, 200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir.

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1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible for patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” - Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

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(c) “Concrete” - Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including selecting, adjusting and transmitting a trade order without any useful, concrete and tangible result and are therefore deemed to be non-statutory.

The claims must be drafted to ensure the use of a computer is undeniable in the process of the invention. To allow for the method to be performed without requiring a computer to do so, falls outside of the prerequisites of 35 U.S.C. 101.

Currently, AT LEAST the claim limitations “processor”, “receiver” and “database” does not require a computer because a “processor” or “receiver” can be understood in the art to be any one person or anything that “processes” and a database can be something as simple as a filing cabinet.

Although the claims are interpreted in light of the specification, limitations from the specification are NOT imported into the claims. The Examiner must give the claim language the broadest reasonable interpretation the claims allow.

See MPEP 2111.01, which states

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims **must be interpreted as broadly as their terms reasonably allow**. In re American Academy of Science Tech Center, F.3d, 2004 WL 1067528 (Fed. Cir. May 13, 2004)

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 18-26, 30-32 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman for the reasons set forth in section 11 of the previous Office action in view of either Official Notice or US Patent 5,557,780 to Edwards et al.

Coleman clearly discloses applicant's invention as explained in section 11 of the previous Office action mailed 4/3/2008.

Coleman does not appear to expressly disclose the following newly added limitations:

said input processor further being configured to:

add static data to the data corresponding to the received invoices when processed into said standard intermediate form;

add dynamic data to the data corresponding to the received invoices when processed into the standard intermediate form; and,

validate the data corresponding to the received invoices when processed into the standard intermediate form before transmission by said transmitter to the party being invoiced.

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Official Notice is taken that it is notoriously old and well known in the banking industry to add static and dynamic data to various paperwork and to verify said data.

For example, before the proliferation of instant check processing at checkout counters it was old and well known that when making a purchase with a check at a store, the store clerk could/would ask for some form of ID and perhaps a phone number. The teller would write this information on the check, verify it and then stick it in the drawer for processing. The static data would be your drivers' license number and the dynamic data would be your phone number.

Accordingly, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Coleman to include the feature of adding either or both static or dynamic data and verify said data for the benefit of ensuring the invoice is processed properly and is actually a legitimate invoice.

If applicant is of the opinion that businesses did not require a driver's license and/or phone number (or some other form of ID) in order to process checks at a checkout counter, then resort may be had to Edwards et al., see for example, Figures 6, 7 and 12 (and associated text) as well as Col. 5 lines 45-52, Col. 11 lines 11-30, etc. to show it is old and well known to add static and dynamic data and to verify said data.

Accordingly, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Coleman with the teachings of Edwards et al. to include the feature of adding either or both static or dynamic data and verify said data for the benefit of ensuring the invoice is processed properly as taught to be old and well known in the invoice processing art.

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New claim 48 mirrors claim 18 and is rejected for at least the same reasons.

8. **Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman as modified and applied to claims 18-26, 30-32 and 48 above in view of US 4,750,114 to Hirtle.**

Coleman as modified discloses applicants' invention substantially as claimed.

Coleman does not appear to explicitly disclose using OSI or Layer 7.

Hirtle teaches in, for example, Col. 3, line 19 through Col. 4, line 39 that it is old and well known to use OSI layer 7 for various reasons.

Finally Layer 7 is the application layer. All layers from 1 to 6 are designed to support this layer. Electronic message systems, terminal emulation capabilities, and file transfer programs are examples of software that may be operating at Layer 7.

Accordingly, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use OSI layer 7 for the benefits derived therefrom as such is no more than the use of systems that are old and well known in the data transfer/invoice routing art.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./

Examiner, Art Unit 3694

2008-10-27

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694